

## **REMARKS**

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of the instant Amendment, Claims 1, 2, and 4-14 will be all of the claims presently pending before the Examiner. Instantly, Claims 1, 2, and 4-10 are amended. Claim 3 is canceled without prejudice. And Claims 11-14 are newly added claims.

Applicants respectfully submit that no new matter has been added by the present amendments. It should be noted that original formula (I) and formula (II) did not accurately reflect the disclosed polyethylene glycol esters, since the repeating unit identified in brackets in the formulae failed to include the oxygen atom. As is generally known to those skilled in the art, polyethylene glycol is represented by the formula  $\text{HO}[-\text{CH}_2-\text{CH}_2-\text{O}-]_n\text{H}$ . Therefore, the Specification and Claims have been amended to correctly set forth the oxygen containing repeating group. Support for the amendments can be found generally throughout the Applicants' disclosure.

It should also be noted that this Amendment is not in acquiescence of the Office's position on the allowability of the claims but made merely to expedite prosecution.

The Office is, therefore, respectfully requested to reconsider the rejections presented in the outstanding Office Action in light of the following remarks.

### **I. Claim Rejections**

#### **A. Rejections under 35 U.S.C. 112**

Claims 1-10 stand rejected under section 112, second paragraph, as being indefinite. Applicants submit the present claims particularly point out and distinctly claim the subject matter of the invention and, therefore, request the withdrawal of these rejections.

As indicated by the Examiner, “n” as set forth in Claim 1, is not defined. However, Applicants submit Claim 1 sets forth “n” as part of the formula (I) and, in addition, recites, *inter alia*, “n represents an integer between 1 and 20....” Therefore, Applicants submit “n” as set forth in the claim is fully defined and meets with the requirements of section 112.

With respect to the Office’s rejection of Claim 3, Applicants note that Claim 3 has been cancelled and thus the rejection is now moot.

Regarding Claim 7, the subject matter complained of has been deleted from the claim and is now the subject of dependent Claim 12 and, as set forth, is in compliance with section 112.

Regarding Applicants’ use of “industrial material,” the Office opines the same is unclear. Applicants respectfully disagree and would like to draw the Office’s attention to the application, which discusses various types of materials that may be subject to root infestation problems and more specifically at Page 3, Lines 19-20, in which there is provided an additional understanding of industrial materials, which are said to include buildings, building materials and building auxiliaries. Furthermore, throughout the specification examples of other industrial materials are provided. It is well established that Section § 112, second paragraph definiteness issues are viewed in light of: a) the content of the specification, (2) the teachings of the prior art, and (3) the claim interpretation given by the skilled artisan, *see, e.g., Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 1370, 77 U.S.P.Q.2d 1625, 1628 (Fed. Cir. 2006).

It is respectfully submitted the claims when viewed in the proper manner, set forth above, particularly point out and distinctly claim the subject matter which the applicant regards as his invention and, therefore, fully comply with the statutory requirements.

Regarding claims 5, 6, and 7, Applicants note that said claims have been amended to affirmatively set forth one or more steps to a process thereby satisfying sections 112 and 101.

For the aforementioned reasons, it is submitted that the above rejections can and should now be withdrawn.

B. 35 U.S.C. 103(a) Rejections

Claims 1-10 presently stand rejected under 35 U.S.C. 103(a) as being obvious over Heuer et al. WO 95/06408, as evidenced by the related English language U.S. patent, Heuer et al. USPN 5,672,568 (hereinafter "Heuer") in view of the reference Swedish J. Agric., 1973, entitled, "Plant Growth Regulators" by Börje Aberg (hereinafter "Aberg"). Applicants respectfully disagree.

As best understood, Heuer relates to the use of specific esters of 2-(4-chloro-2-methylphenoxy)-propionic acid ("MCPP-acid"). As taught therein, the selection of the type of ester to become part of the MCPP-acid can affect the root inhibitory efficiency of the product formed. Furthermore, Heuer appears to disclose racemic esters of MCPP-acid. In stark contrast to the present invention, Heuer fails to teach or suggest the use of enantiomerically enriched polyethylene glycol esters of R-(+)-2-(4-chloro-2-methylphenoxy)-propionic acids ("R-(+)-MCPP-acid").

As best understood, Aberg demonstrates in herbicidal applications that the R-(+)-MCPP-acid isomer is more effective than the S-(-)-MCPP-acid isomer. Like Heuer, Aberg also fails to teach or suggest the use of enantiomerically enriched polyethylene glycol esters of R-(+)-MCPP-acids.

Since Aberg fails to relate to esters of MCPP-acids and since the selection of various types of esters could affect the efficiency of the final product formed, the skilled artisan would simply not have found it obvious to create and/or use enantiomerically enriched polyethylene glycol esters of R-(+)-MCPP-acids as presently claimed.

In light of the above, Applicants request the withdrawal of the present obviousness rejections.

C. Double Patenting Rejection

Claims 1-10 are rejected on grounds of non-statutory obviousness type double patenting over Claims 1-14 of Heuer et al. USPN 5,675,032 (hereinafter '032").

As best understood, the '032 patent relates to the production of polyethylene glycol esters of MCP-PP-acids. However, the '032 reference fails to disclose the enantiomeric relationship of the polyethylene glycol esters of MCP-PP-acids. Since the presently claimed invention is clearly drawn to enantiomerically enriched polyethylene glycol esters of R-(+)-MCP-PP-acids, the claims of the '032 cannot render the same obvious and, therefore, said claims cannot serve as a proper obvious-type double patenting rejection.

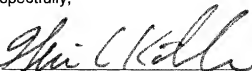
Applicants request the withdrawal of these rejections at this time.

II. **Conclusion**

In view of the foregoing, it is respectfully submitted that independent claim 1 is fully distinguishable over the applied art and is thus in condition for allowance. By virtue of dependence from what is believed to be an allowable independent claim 1, it is respectfully submitted that claims 2 and 4-14 are also presently allowable. Notice to the effect is earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

The USPTO is hereby authorized to charge any fees, including any fees for an extension of time or those under 37 CFR 1.16 or 1.17, which may be required by this paper, and/or to credit any overpayments to Deposit Account No. 50-2527.

Respectfully,

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